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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 10/520,664 | 01/10/2005 | Mairi Elizabeth Raggatt | 056258-5089 | 9397 |

9629 7590 01/09/2007
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

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| EXAMINER |
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SHAH, MANISH S

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2853

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 01/09/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/520,664 | Applicant(s) RAGGATT, MAIRI ELIZABETH | |
| | Examiner Manish S. Shah | Art Unit 2853 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>8/19/05:1/10/05</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7 & 9-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,979,364 in view of Chino et al. (# US 2003/0125530).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed in the US Patent and is covered by the US Patent, since the US Patent and the instant application are claiming common subject matter, as follows as shown in

Table: 1 below.

TABLE: 1

| | |
|---|--|
| <p># 10/520664 CLAIMS</p> <p>1. An ink comprising: (a) a metal chelate compound of formula (1) or salt thereof, wherein M is nickel;</p> <div data-bbox="142 506 537 873"> </div> <p>and (b) a liquid medium.</p> | <p># 6,979,364 CLAIMS</p> <p>7. An ink comprising: (a) a compound according to any one of claims 2, 4 and 5 and (b) a liquid medium.</p> <p>5. A compound according to claim 1 having the following formulae or salt thereof, wherein M is nickel:</p> <p>Compound (1)</p> <div data-bbox="786 646 1180 1014"> </div> <p>1. A compound of formula 5 or 6:</p> <p>Formula (5)</p> <div data-bbox="802 1083 1036 1268"> </div> <p>Formula (6)</p> <div data-bbox="802 1293 1133 1440"> </div> |
| <p>2. An ink according to claim 1 wherein the liquid medium comprises a mixture of water and an organic solvent.</p> <p>4. A process for printing an image on a substrate comprising applying thereto by means of an ink jet printer an ink according to claim 1 or claim 2.</p> <p>5. A substrate printed by means of the process according to claim 1 or 2.</p> <p>6. An ink jet printer cartridge comprising a chamber and ink, wherein the ink is present in the chamber and the ink is as defined in claim 1 or 2.</p> <p>7. An ink jet printer containing an ink jet printer cartridge, wherein the ink jet printer cartridge is as defined in claim 6.</p> | <p>8. An ink according to claim 7 wherein the liquid medium comprises a mixture of water and an organic solvent.</p> <p>9. A process for printing an image on a substrate comprising applying thereto by means of an ink jet printer an ink according to claim 7.</p> <p>10. A substrate printed by means of the process according to claim 9.</p> <p>11. An ink jet printer cartridge comprising a chamber and ink, wherein the ink is present in the chamber and the ink is as defined in claim 7.</p> <p>12. An ink jet printer containing an ink jet printer cartridge, wherein the ink jet printer cartridge is as defined in claim 11.</p> |

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US Patent didn't disclosed in the claim that the an ink comprising 1 to 10 part of compound 1; 2 to 60 part of water soluble organic solvent ; and 30 to 97 part of water.

In the above US Patent, it is the examiner's position that it would have been obvious to one having ordinary skill in the art that: the ink includes 1 to 10 part of compound 1; 2 to 60 part of water soluble organic solvent ; and 30 to 97 part of water since the dye structure and organic solvents of the US Patent are the same dye structure as those claimed by applicants in the present application.

Chino et al. teaches that to have a light fastness printed image, ink composition includes 1 to 10 part of compound one; 2 to 60 part of water-soluble organic solvent ; and 30 to 97 part of water ([0058]-[0059]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ink composition of US Patent (364) by the aforementioned teaching of Chino et al. in order to have an excellent light fastness and high quality printed image.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

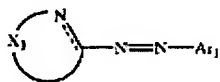
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1-7 & 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Chino et al. (# US 2003/0125530 A1).

Chino et al. discloses an ink comprising a metal chelate compound of formula as shown below, wherein metal is nickel, and liquid medium (see Abstract; see Table: 1, 8 (1-1, 1-2, 6-15), [0113]-[0118]), wherein liquid medium is a mixture of water and organic solvent ([0059]). They also disclose that ink includes 1 to 10 part of the metal chelate compound ([0058]); 2 to 60 part of water-soluble organic solvent, and 30 to 97 part of water ([0059]). They also disclose a process of printing an image on substrate including applying ink composition using inkjet printer, wherein printer comprises ink cartridge ([0147]).



wherein the heterocyclic ring containing X_1 is a triazole ring or the like; and Ar_1 represents naphthyl group having a chelated group.

6-15

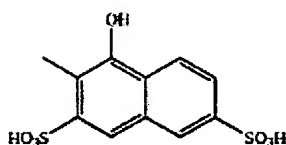
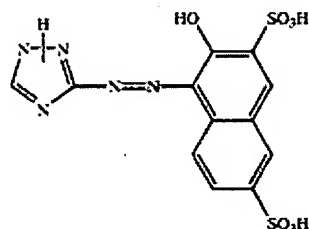


TABLE 1

| No. | |
|-----|--|
| 1-1 | |
| 1-2 | |

(L1)



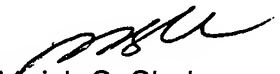
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Manish S. Shah
Primary Examiner
Art Unit 2853

MSS

1/5/07